

Exhibit 1

Joint Statement Regarding Plaintiff's Discovery Responses (Redacted)

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UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

IMPOSSIBLE FOODS INC.,
Plaintiff,
v.
IMPOSSIBLE LLC and JOEL RUNYON,
Defendants.

Case No. 5:21-cv-02419-BLF
(SVK)
Judge: Hon. Beth Labson Freeman
**JOINT STATEMENT
REGARDING PLAINTIFF'S
DISCOVERY RESPONSES**

1 Pursuant to Section 8 of the Civil and Discovery Referral Matters Standing Order of
2 Magistrate Judge Susan van Keulen, Defendant Impossible LLC (“Defendant”) respectfully
3 requests an order compelling Plaintiff Impossible Foods Inc. (“Plaintiff”) to produce all
4 documents responsive to Request for Production Nos. 34 and 36, as described below.

5 Individual defendant Joel Runyon concurs with Defendant’s positions herein, but as the
6 requests were served on behalf of Defendant only, Mr. Runyon has not joined this motion.

7 As of the date of filing, there are 98 days remaining in the discovery period, which is
8 currently set to close on April 14, 2025.

9 Attached as Exhibit A is a joint chart as required by Section 8 of the Standing Order.

10 Request Nos. 34 and 36, included in Defendant’s first set of requests for production
11 (attached hereto as Exhibit B), seek production from Plaintiff as follows:

12 Request No. 34: Produce all non-privileged communications between Plaintiff
13 and third parties concerning use of Plaintiff’s Marks or any marks similar to
14 Plaintiff’s Marks, including any demand letters sent or received by Plaintiff and
any responses thereto.

15 Request No. 36: Produce all documents regarding trademark enforcement actions
16 taken by or against Plaintiff regarding any mark that includes the term
17 IMPOSSIBLE, and documents sufficient to identify the party seeking to enforce
its mark, the asserted mark(s), the alleged infringing mark(s), and the resolution
of the dispute.

18 Defendant served these requests on March 12, 2024; Plaintiff served its responses on May 13,
19 2024 (attached as Exhibit C), refusing to produce any documents. The parties exchanged
20 correspondence regarding the requests on June 3 and 17, 2024; conferred on June 17, 2024; and
21 exchanged further correspondence following conferral on June 17 and 24, 2024. Following an
22 informal pause in discovery as the parties explored settlement and Plaintiff sought to amend its
23 complaint, Defendant sent correspondence on October 17, 2024, revisiting the last exchange; the
24 parties exchanged further correspondence on October 19 and 25, 2024.

25 In its October 25, 2024 correspondence, Plaintiff stated that “[w]e have produced
26 documents responsive to Request Nos. 34 and 36 and will continue to do so as discovery and our
27 investigation is ongoing.”¹ Plaintiff’s only production as of that date included 23 demand letters
28

¹ In view of the Court’s standing orders on discovery disputes, the parties’ correspondence has not
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1 sent by in-house and outside counsel to alleged trademark infringers. Plaintiff confirmed that it
2 had produced responsive documents during a meet and confer on October 31, 2024.

3 As discussed more fully in the argument below, a third-party subpoena response from the
4 target of one of Plaintiff's demand letters demonstrated that Plaintiff did not produce all
5 documentation responsive to Request Nos. 34 and 36, and Defendant believes that Plaintiff failed
6 to produce particularly probative information. Defendant sent a letter to Plaintiff on November
7 27, 2024, explaining (and concurrently producing) the subpoenaed documents that Defendant
8 asserts demonstrate Plaintiff's withholding of highly probative documents.

9 Plaintiff responded on December 6, 2024, stating that "[w]hile we agreed that
10 enforcement-related documents are generally relevant to this action," Plaintiff believed that
11 Request Nos. 34 and 36 "are overly broad requests that are disproportionate to the needs of this
12 case," and narrowed their previously agreed responses to only "enforcement letters" and
13 "settlement agreements." Defendant responded on December 13, 2024, disagreeing with
14 Plaintiff's objections and insisting upon production of all enforcement correspondence, in light
15 of the revelations through third-party subpoenas. The parties met and conferred once again on
16 December 20, 2024.

17 The parties have both proposed compromises that render Request Nos. 34 and 36
18 overlapping, and therefore they are discussed together below.

19 **Defendant's Position: Defendant requests that the Court require production of all**
20 **documentation reflecting correspondence regarding enforcement of its trademarks that**
21 **include the term IMPOSSIBLE, which are responsive to both Request Nos. 34 and 36.**

22 The relevance of these documents has already been acknowledged by Plaintiff.
23 Enforcement correspondence shows the manner in which Plaintiff characterizes its marks to the
24 public, which are evidence of the nature of the marks themselves, and implicate the credibility of
25 Plaintiff's assertions in this case. *See, e.g., GT Beverage Co., LLC v. Coca-Cola Co.*, No.
26 SACV100209JVSRNBX, 2010 WL 11595890, at *1 (C.D. Cal. Sept. 16, 2010) (compelling

27
28 been included in this submission. Defendant is happy to provide copies of the correspondence at
the Court's request.

1 discovery into correspondence that could contain statements inconsistent with a party's position
2 in litigation).

3 Further, the ways in which Plaintiff has asserted its trademarks, and objected to third
4 parties' uses of arguably similar marks, are evidence of the scope of the exclusive rights Plaintiff
5 possesses. The scope of a trademark is defined by public perception—whether consumers would
6 encounter a certain mark applied to certain goods, and associate it back to the mark holder. The
7 scope is therefore impacted by similar uses in the market by third parties—if others use a mark,
8 or similar marks, in commerce with certain goods, the public will be trained to recognize that the
9 mark in that context does not identify the original mark holder as the source of goods. *E.g.*,
10 *PostX Corp. v. docSpace Co.*, 80 F. Supp. 2d 1056, 1061 (N.D. Cal. 1999) (“The presence of
11 those marks (and those marks which plaintiff contends are ‘dissimilar’ but which clearly use, to
12 varying degrees, elements of plaintiff’s mark’s design, including the keyhole) to represent their
13 computer security services or products weakens plaintiff’s mark.”).

14 Defendant believes that it is entitled to all responsive documents for the simple fact that
15 they are evidence illuminating Plaintiff’s views of its own marks. But beyond this general
16 relevance, a recent third-party subpoena response indicates a non-hypothetical and pressing need
17 for this documentation: the subpoena response shows that Plaintiff has previously taken positions
18 regarding the scope of its marks that contradict its infringement claims against Defendant. In this
19 case, Plaintiff has asserted that its trademarks are broad enough to exclude Defendant’s use of its
20 mark in association with any “edible products.” Dkt. No. 103 ¶ 35 (defining the “Accused
21 Products”). Yet, subpoenaed documentation not produced by Plaintiff demonstrates that Plaintiff

22 [REDACTED]
23 supplement products of the type Defendant offers/intends to offer, and Plaintiff specifically
24 complained of in its claims in this case. After months-long back-and-forth email correspondence
25 between the third party’s and Plaintiff’s counsel (none of which Plaintiff produced in this action),

26 [REDACTED]
27 [REDACTED]
28 [REDACTED] This narrow limitation stands in stark contrast to the

1 assertions made in this case, that any and all “edible products” sold by Defendant infringe
2 Plaintiff’s marks.

3 Having already acknowledged relevance, and providing no concrete information about
4 how these searches create undue burden (*see In re Cathode Ray Tube (CRT) Antitrust Litig.*, No.
5 C-07-5944 JST, 2018 WL 4378727, at *2 (N.D. Cal. Apr. 25, 2018) (“Simply saying that
6 discovery is burdensome is not enough; a burden objection requires a showing of actual
7 burden.”)), Plaintiff objects to production of enforcement correspondence based solely on
8 proportionality under Rule 26(d)(1). As an initial matter, this proportionality objection was not
9 raised in Plaintiff’s written response to Request No. 34 (*see Ex. B*), nor was it stated when
10 Plaintiff agreed to produce documents in response to both requests on October 25, 2024, and is
11 thus waived. *See Richmark Corp. v. Timber Falling Consultants*, 959 F.2d 1468, 1473 (9th Cir.
12 1992) (“It is well established that a failure to object to discovery requests within the time
13 required constitutes a waiver of any objection.”).

14 But even if not waived, the proportionality of these requests is readily apparent. Whether
15 Plaintiff has acquiesced to third-party uses similar to Defendant’s allegedly infringing use speaks
16 to the central infringement question of consumer confusion; the discovery also speaks to
17 Plaintiff’s credibility, in view of its numerous assertions that its trademark rights encompass all
18 edible goods. Plaintiff has threatened enhanced damages and injunctive relief based on alleged
19 willful infringement, and thus the amount in controversy is high. Plaintiff has demonstrated that
20 it does not intend to produce this information absent a Court order directing it to do so, and the
21 only other way to obtain it is through subpoena practice that transfers Plaintiff’s discovery
22 burdens to third parties. And the parties’ relative resources favor Plaintiff (as the multimillion
23 dollar corporation that brought this suit) expending the resources to identify this information,
24 rather than placing an even higher cost on Defendant (a single-member LLC) to go seek the
25 information from each of Plaintiff’s enforcement targets individually.

26 Plaintiff’s proposed compromise, that it will produce demand letters and settlement
27 agreements, is insufficient to provide information that addresses Defendant’s concerns. The
28 compromise would exclude the precise documentation that demonstrates Plaintiff’s previous

1 trademark acquiescence that is contrary to Plaintiff's infringement assertion in this case, and
2 which was contained entirely in email correspondence. The subpoenaed documents show that
3 relevant and probative information can and does appear in broader communications, and thus the
4 compromise does not meet Defendant's discovery needs.

5 Finally, Defendant notes that discovery into all enforcement efforts is necessary in view
6 of Plaintiff's misleading statements regarding its responses to Request Nos. 34 and 36. Plaintiff
7 had agreed to produce responsive information as of October 25, 2024; it was only after
8 Defendant independently uncovered responsive, unproduced, and *damaging* documentation that
9 Plaintiff belatedly asserted its current proportionality argument. Plaintiff's efforts to narrow its
10 obligations, rather than correct its demonstrated shortcomings, leaves Defendant dubious that
11 any compromise offered by Plaintiff will actually capture the relevant information. Defendant
12 also fears that if Plaintiff is given any discretion to choose which enforcement documentation is
13 produced, Plaintiff will again exclude damaging information. Defendant therefore respectfully
14 requests the Court's intervention to require production of all documentation reflecting
15 enforcement correspondence.

16 **Plaintiff's Position: The Court should find that Plaintiff's production of cease-and-**
17 **desist letters and settlement agreements in response to Request Nos. 34 and 36 is**
18 **proportional to the needs of the case.**

19 Plaintiff has already agreed to produce cease-and-desist letters and settlement agreements
20 from its efforts to enforce its trademark rights against third parties. Defendants' demand that
21 Plaintiff also collect and produce *all* correspondence between Plaintiff and those third parties is
22 disproportionate to the needs of the case.

23 Trademark infringement disputes are "intensely factual [in] nature." *Rearden LLC v.*
24 *Rearden Commerce, Inc.*, 683 F.3d 1190, 1202 (9th Cir. 2012). Indeed, the Ninth Circuit uses a
25 "flexible, multi-factored approach" in "assessing whether a party's actions are likely to create
26 confusion." *Cornerstone Staffing Sols., Inc. v. James*, 2013 WL 12124430, at *6 (N.D. Cal. Oct.
27 21, 2013). For this reason, allegations of trademark infringement and likelihood of confusion
28 against *third parties* are of marginal relevance to whether there is a likelihood of confusion in

1 *this case.*

2 The court in *Pennsylvania State Univ. v. Vintage Brand, LLC*, — F. Supp. 3d —, 2024
3 WL 4665186, at *5 (M.D. Penn. Nov. 4, 2024) conducted an extensive analysis of this issue and
4 concluded that evidence of a party’s trademark disputes with third parties was inadmissible at
5 trial. As the *Vintage Brand* court observed:

6 [E]very case is unique, and the circumstances surrounding every alleged trademark
7 infringement are unique. . . .

8 [E]ach alleged act of infringement is factually unique, which would further diminish
9 the relevance of other lawsuits or disputes as related to Vintage Brand’s willfulness.
10 Factual questions relevant to each alleged act of infringement include issues such as,
11 for example, whether the infringement involved composite images or direct use of
12 trademarks, whether the defendant conducted research into whether images were
13 trademarked, or whether any trademarks had obtained indisputable status. This
14 would necessitate an examination of the underlying cases, conduct, and trademarks
15 to determine whether the conduct there was similar to Vintage Brand’s conduct in
16 this matter, which would not only have the potential to confuse the jury, but would
17 undoubtedly waste significant amounts of time.

18 *Id.*

19 Other courts have refused to compel production of trademark infringement
20 correspondence with third parties, applying similar reasoning. In *Fossil Group, Inc. v. Angel*
21 *Seller LLC*, 2021 WL 5181308 (E.D.N.Y. Oct. 22, 2021), the court noted “that a defendant being
22 sued for trademark infringement can[not] demand all evidence regarding the plaintiff’s prior
23 trademark enforcement efforts and settlement agreements.” *Id.* at *6. In *Reflex Media, Inc. v.*
24 *Luxy Ltd.*, 2021 WL 5937650, (C.D. Cal. Oct. 20, 2021), the Central District found that
25 discovery requests seeking “[d]emand letters, cease-and-desist letters, settlement agreements,
26 and communications with third parties concerning . . . the marks at issue” were neither “relevant”
27 nor “proportional to the needs of this case.” *Id.* at *9.

28 Here, even if Defendants are correct that Impossible Foods “acquiesced” to a third party

(it did not), such evidence is not relevant to *this* case because each trademark dispute is unique and must be analyzed according to the non-exhaustive *Sleekcraft*. The Ninth Circuit does not permit a finder of fact to compare one trademark litigation to another, as Defendants seek to do. *See Century 21 Real Est. Corp. v. Sandlin*, 846 F.2d 1175, 1181 (9th Cir. 1988) (“[D]iscovery that revealed other potential infringers would be irrelevant under the law of this circuit and of California.”).

Impossible Foods has already agreed to produce cease-and-desist letters and settlement agreements with third parties involving Impossible Foods’s asserted marks—a compromise which exceeds the bounds of proportionality. The Court should not compel Impossible Foods to collect every back-and-forth with those third parties just so that Defendants can mine them for potential statements that might be “inconsistent” with Impossible Foods’s positions in this case. The law does not support Defendants’ demand.

Defendants’ argument that Impossible Foods “waived” the issue of proportionality is incorrect. During a conferral on October 31, 2024, Impossible Foods’s counsel discussed the proportionality of producing “all” documents and communications concerning Impossible Foods’s enforcement efforts against third parties. Impossible Foods also made proportionality objections in its written responses, both in its General Objections and in response to Request No. 36. *Id.*

In any event, “under Rule 26, relevance is simply the initial hurdle a party seeking discovery must pass” and the “second hurdle Defendant[s] must clear is proportionality.” *See Schutza v. Costco Wholesale Corp.*, No. 19-CV-990-H(WVG), 2020 WL 13885645, at *2 (S.D. Cal. Apr. 10, 2020). The “moving party bears the burden of not only demonstrating [the relevance of] the requested discovery, but also that it has satisfied proportionality and other requirements of Rule 26.” *Hegarty v. Transamerica Life Ins. Co.*, No. 19CV06006-MMC (RMI), 2021 WL 4899482, at *2 (N.D. Cal. Oct. 21, 2021) (denying motion to compel production where moving party did not demonstrate relevance and proportionality of requests). Further, “the Court may sua sponte review discovery requests for proportionality” under Rule 26(b)(2)(C). *Philhower v. Philhower*, No. 8:24-CV-00074-MRA (JDEX), 2024 WL 4720932, at *6 (C.D. Cal.

Oct. 15, 2024); *see also Laszloffy v. Garcia*, No. 2:19-CV-01173-JAD-BNW, 2024 WL 4213689, at *3 (D. Nev. Feb. 23, 2024) (“While Defendants have not lodged a proportionality objection, the Court has an independent duty under Rule 26(b)(2)(C) to consider whether the request is indeed proportional to the needs of the case.”). Accordingly, the issue of proportionality is properly before the Court.

In sum, Defendants’ demand for *all* documents and communications relating to Impossible Foods’s trademark enforcement efforts against third parties is disproportionate to the needs of the case. By agreeing to produce responsive demand letters and settlement agreements, Impossible Foods has already complied with its obligations under Rules 26 and 34. Defendants’ motion should therefore be denied.

Respectfully submitted,

Date: January 6, 2025

By: /s/ Adrienne J. Kosak

By: /s/ Jessica W. Truelove

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CERTIFICATE OF SERVICE

I hereby certify that on January 6, 2025, the foregoing was served electronically on all
counsel of record.

/s/ Adrienne J. Kosak
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